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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/036,599

11/09/2001

Koji Morita

36856.584

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7590

07/14/2004

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EXAMINER

TUGBANG, ANTHONY D

ART UNIT

PAPER NUMBER

3729

DATE MAILED: 07/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/036,599

Applicant(s)

KOJI ET AL

Examiner

A. Dexter Tugbang

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 12-20 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 12-19 is/are rejected.
- 7) ☒ Claim(s) 20 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☒ Certified copies of the priority documents have been received in Application No. 09/412,204.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>3</u> . | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Specification

1. The abstract of the disclosure is objected to because the abstract is not directed to the claimed invention, i.e. process of making. Correction is required. See MPEP § 608.01(b).
2. Applicant is reminded of the proper content of an abstract of the disclosure.

A patent abstract is a concise statement of the technical disclosure of the patent and should include that which is new in the art to which the invention pertains. If the patent is of a basic nature, the entire technical disclosure may be new in the art, and the abstract should be directed to the entire disclosure. If the patent is in the nature of an improvement in an old apparatus, process, product, or composition, the abstract should include the technical disclosure of the improvement. In certain patents, particularly those for compounds and compositions, wherein the process for making and/or the use thereof are not obvious, the abstract should set forth a process for making and/or use thereof. If the new technical disclosure involves modifications or alternatives, the abstract should mention by way of example the preferred modification or alternative.

The abstract should not refer to purported merits or speculative applications of the invention and should not compare the invention with the prior art.

Where applicable, the abstract should include the following:

- (1) if a machine or apparatus, its organization and operation;
- (2) if an article, its method of making;
- (3) if a chemical compound, its identity and use;
- (4) if a mixture, its ingredients;
- (5) if a process, the steps.**

Extensive mechanical and design details of apparatus should not be given.

3. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

The following title is suggested: A Method of Manufacturing a Piezoelectric Component.

Claim Objections

4. Claims 12 and 20 are objected to because of the following informalities.

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In Claim 12, the term "a" (line 4) should be deleted and the phrase of "the" (1st occurrence on line 7) should be replaced with --an--.

In Claim 20, the term "layers" (line 2) should be replaced with --elastic materials--, the term "the" (3rd occurrence on line 2) should be replaced with --a--, and the term "the" (1st occurrence and 3rd occurrence on line 3) should be replaced with the term --a--.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 13-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In Claim 13, the phrase of "the thixotropic index" (line 1) lacks positive antecedent basis.

The same problems in Claim 13 above also occur in each of Claims 14 and 15.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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8. Claims 12 and 19 are rejected under 35 U.S.C. 102(b) as being anticipated by Daidai et al. 5,593,721.

Daidai discloses a method of manufacturing a piezoelectric component comprising: forming an unhardened first elastic material 10 partially on at least a pair of end portions of a piezoelectric element 1, the pair of end portions including edge portions of the piezoelectric element; hardening the first elastic material (see col. 4, lines 15-17); forming an unhardened second elastic material 11 on an entire circumference of the piezoelectric element and the first elastic material; hardening the second elastic material (see col. 4, lines 23-31); forming an unhardened outer-cladding resin 13 on the entire circumference of the second elastic material covering the piezoelectric element and the first elastic material; and hardening the outer-cladding resin (see col. 4, lines 56-61).

Regarding Claim(s) 19, Daidai further teaches forming the outer-cladding resin by dipping the piezoelectric element into a fluid state of the outer-cladding resin (see col. 4, lines 59-62).

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 13-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Daidai et al.

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Daidai discloses the claimed manufacturing method as previously discussed above, and further including that the unhardened first elastic material and the unhardened second elastic material are made of different compositions of materials. The amount of the thixotropic index that the unhardened first elastic material is larger than the unhardened second elastic material, or that the thixotropic indexes of both the unhardened first and second elastic materials being larger than 1.7, are each considered to be an effective variable within the level of ordinary skill in the art of forming unhardened first and second elastic materials in a piezoelectric component. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have provided such thixotropic indexes, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

11. Claims 16-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Daidai et al in view of the Applicants Admitted Prior Art, referred to hereinafter as AAPA.

Daidai discloses the claimed manufacturing method as previously discussed above. Daidai does not teach that the first elastic material is formed of silicone rubber in which the piezoelectric element is dipped in a fluid state of the first elastic material, and that the second elastic material is formed by dipping the piezoelectric material into a fluid state of the second elastic material. However, these features above are conventional and notoriously well known in the art of manufacturing piezoelectric components. The AAPA (specification, pages 1-2) discloses the above conventional features.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the method of Daidai by including the conventional features taught

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by the AAPA, to at least realize the advantages of packaging and encapsulating the piezoelectric component.

Allowable Subject Matter

12. Claim 20 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

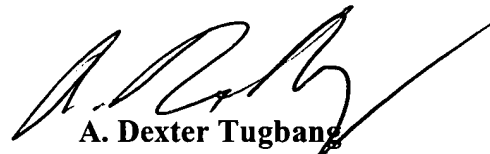
14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to A. Dexter Tugbang whose telephone number is 703-308-7599.

The examiner can normally be reached on Monday - Friday 7:00 am - 3:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Vo can be reached on 703-308-1789. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



A. Dexter Tugbang
Primary Examiner
Art Unit 3729

July 9, 2004